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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,619	11/10/2003	Steve Marangoni		4687
7590	03/22/2004		EXAMINER	
Steve Marangoni 16 Buckskin Lane Riverhead, NY 11901			CHIU, RALEIGH W	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/705,619	MARANGONI, STEVE
	Examiner Raleigh Chiu	Art Unit 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/10/2003</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because of the presence of "means" language. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC §§ 102 and 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,368,406 (Hanshaw).

Regarding claim 1, Figure 1 of Hanshaw discloses a shaft 22 with a conical tip inherently capable of being inserted within a space between racquet strings. Figure 1 also shows the recited clip 34 attached to the upper shaft portion. The flared portion near barrel member 18 is considered to correspond to the recited generally annular flared portion; the Hanshaw flare would inherently function to stop movement into a space beyond a certain degree. Applicant is reminded that prior art meeting the structural limitations of the claims and that is inherently capable of performing the intended use fully meets the claims under 35 USC 102.

Regarding claim 2, knurled finger portions 62 would inherently provide a friction grip.

Regarding claim 4, Hanshaw discloses the use of logos on the pen. See column 2, lines 16-29.

6. Claims 3, 5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanshaw as applied above.

Regarding claims 3 and 5, pens are old and well-known in the art to be made of plastic and approximately three inches in length.

Regarding claims 7-11, Hanshaw discloses the recited elements but shows an upper shaft male threaded portion and lower shaft female threaded portion. It would have been obvious to one of ordinary skill in the art to reverse the positions of the threaded mating portions where it is immaterial which portion has which particular mating thread.

Regarding claim 12, Hanshaw discloses that the hollow shaft may contain medicinal tablets. See column 4, lines 28-36.

7. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanshaw as applied above in view of UK Patent Application 2,162,127 (Beffa).

Regarding claims 14-19, although Hanshaw does not show a hinged cap which would reveal a storage cavity, it would have been obvious to include a cap on the Hanshaw pen in view of Beffa who shows in his Figures 1-5 that it is old and well-known in the art to cover containers in combination with pen/tablet

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storage areas with a cap. Common fasteners such as threads, hinges and snaps are considered to be functional equivalents and one of ordinary skill in the art would have found it obvious to use any known fastener to attach the cap to the pen.

8. Claims 6, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanshaw as applied above in view of U.S. Patent Number 5,050,053 (McDermott).

Regarding claims 6, 13 and 20, it would have been obvious to one of ordinary skill in the art to include an aperture on the Hanshaw clip in view of McDermott who teaches exactly such a concept as another means for carrying the device. See McDermott's aperture 75 on clip 72 in Figures 18-20 and the bridging paragraph between columns 5-6.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes, can be reached on (703) 308-1806.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu  
Primary Examiner  
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RWC:dei:feif  
18 March 2004